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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/401,632	09/22/99	SCHLESINGER	R 5050/582
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QM12/1019

EXAMINER

SERKE, C

ART UNIT

PAPER NUMBER

3763

DATE MAILED:

10/19/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.  
09/401,632

Applicant(s)

Schlesinger et al.

Examiner  
Catherine Serk

Group Art Unit  
3763



☒ Responsive to communication(s) filed on Jul 31, 2000

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-47 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-24 and 26-46 is/are rejected.

☒ Claim(s) 25 and 47 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims ~~1~~ 4-~~10~~ <sup>15</sup>12-16, 21 ~~24~~, 28-~~29~~, 32-35, ~~38~~ and 42-46 are rejected under 35

U.S.C. 102(b) as being anticipated by Hamm et al.

Hamm et al disclose an ultrasound imaging guidewire which during use is part of a catheter system. The device includes conductor 103, shaft 29, non-conductive braid 110 (knitted layer of Kevlar, see 15: 16+), ultrasound transducer assembly 23, dielectric film (silicone oil) 12, window 31, and floppy tip 26. It is considered inherent that the device has a control for the braid 110 in light of the fact that the device has torqueability and pushability from the proximal region.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-3, 11, 17-20, 26-27, 30-31, 36-37, 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamm et al.

Hamm et al meet the claim limitations as described above but fail to include the non-conductive braid being made from a monofilament, a monofilament nylon, or a monofilament liquid crystal polymer material; the dielectric film being made from a tape, polyester, or Mylar material; and the dielectric film having a thickness of less than 7 microns.

At the time of the invention it would have been obvious to substitute the dielectric braid of Hamm et al with a monofilament, a monofilament nylon, or a monofilament liquid crystal polymer material in view of the fact that these are well known catheter shaft materials and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

At the time of the invention it would have been obvious to substitute the dielectric film of Hamm et al with tape, polyester, or Mylar material in view of the fact that these are well known insulators in the catheter art and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

At the time of the invention it would have been obvious to make the dielectric film of Hamm et al with having a thickness of less than 7 microns since the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative

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dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

*Allowable Subject Matter*

5. Claims 25 and 47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Response to Arguments*

6. Applicant's arguments with respect to claims 1-47 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Serke whose telephone number is (703) 308-4846. The examiner can normally be reached on Monday-Friday from 8:30 am to 5:00 pm.

8. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Sharon Kennedy, can be reached on (703) 305-0154. The fax number for this Group is (703) 305-3590.

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9. Any inquiry of a general nature or relating to the status of the application should be directed to the Group receptionist whose telephone number is (703) 308-0858.

  
Sharon Kennedy  
Primary Examiner

G.

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October 17, 2000